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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CULBERT, ROBERTS P

ART UNIT

PAPER NUMBER

1763

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/758,067

Applicant(s)

HOLLAND ET AL.

Examiner

Roberts Culbert

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I claims 1-7, in Paper No. 5 is acknowledged. Group I now includes claims 9-11 submitted 9/19/02. The traversal is on the ground(s) that the metal article of claims 8 and 12-21 can only be made by the process of claims 1-7 and 9-11, and that the process of claims 1-7 and 9-11 can only be used to make the metal article of claims 8 and 12-21. This is not found persuasive because a different process such as polishing without agitation can make the metal article of claims 8 and 12-21.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "superior" in claim 7 is a relative term that renders the claim indefinite. The term "superior" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Art Unit: 1763

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,818,333 to Michaud et al. Michaud teaches a method for finishing a metal article including placing the metal article in a agitating finishing apparatus (col. 2, lines 31-32), contacting with a solution capable of converting the surface of the metal to a softer form (col. 2, lines 29-30), introducing nonabrasive media elements (col. 2, lines 35-36 and col. 3, lines 6-11), and agitating the metal article, media, and solution for a period of time to enhance surface properties (col. 2, lines 31-32) such as smoothness (col. 1, lines 10-14) and brightness (col. 2, lines 17-21). The nonabrasive media elements are made from a material that includes a metal (col. 4, lines 42-44). The surface property of the metal is superior to that produced by non-abrasive ceramic media or other abrasive media (col. 5, lines 33-37). The finishing apparatus is vibratory (col. 3, lines 50-52).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 1763

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 4,818,333 to Michaud et al, in view of U.S. Patent 3,684,466 to Petrone. As applied above, Michaud discloses the method of the invention substantially as claimed, but does not show the use of a media made from plastic or from alumina bonded with an unsaturated polyester resin.

Petrone does teach the use of a media made from alumina bonded with an unsaturated polyester resin. (See claims 1 and 2) It would have been obvious to one of ordinary skill in the art at the time of invention to use the media of Petrone in the method of Michaud in order to increase the durability of the media as suggested by Petrone. (See col. 2 lines 5-7)

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 4,818,333 to Michaud et al, in view of U.S. Patent 4,307,544 to Balz. As applied above, Michaud discloses the method of the invention substantially as claimed, but does not show the use of a media made from stainless steel. Balz teaches that stainless steel is a suitable finishing media for use in a vibratory type finisher (col. 7, lines 20-25). It would have been obvious to one of ordinary skill in the art at the time of invention to use the media of Balz in the method of Michaud since Balz teaches the suitability of the media for the intended purpose. (See MPEP 2144.07)

Regarding the use of 302 stainless steel, the selection of a common grade of steel would have been obvious to one of ordinary skill in the art at the time of invention as a matter of routine experimentation in order to produce surface properties that are optimized.

Art Unit: 1763

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (703) 305-7965. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

November 25, 2002

  
GREGORY MILLS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700